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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,613	12/16/2003	Shigeo Fukuda	FUKU3001/EM	2775
23364	7590	11/07/2005	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			RESAN, STEVAN A	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,613

Applicant(s)

FUKUDA, SHIGEO

Examiner

Stevan A. Resan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai JP 11-103915.

See Fig 3 (a) and Fig 4 (a). Figure 4 (a) is an embodiment where each spherical magnet may have a colored coating. The magnets are taught to have a powerful magnetic force e.g. a neodymium magnet [004].

3. Claims 7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai as applied to claim 6 in view of Yellen US 64274, Ishikawa US 4,095,587 and Hoffman US 4517217 for the reasons of record and as further explained below.

4. Applicant's arguments with respect to claims 6 and 8 have been considered but are moot in view of the new ground(s) of rejection. .

Applicant's arguments with respect to claims 7, 9, 10, 12 and 13 filed 26 September 2005 have been fully considered but they are not persuasive.

Applicants traverse the rejection under 35 USC 103 on the basis that Yellen teaches away from the step wherein a plated layer is formed on the surface of the permanent magnet unit and a transparent siliceous layer is formed over the plated layer (i.e. the limitation found in present claim 10). However the examiner strongly disagrees with this characterization of the teachings of Yellen. While Yellen teaches that the bodies of the invention are composed of magnetic material exclusive of decorative and

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protective coatings there is no prohibition of the use of these coatings over the invention. The examiner interprets this teaching to mean that decorative and protective coatings are not required as part of the invention. Note that Sakurai JP 11-103915 is cited as a foreign patent document on the face of Yellen. Therefore the changing of the appearance of the outside surfaces of the magnets is still deemed prima facie obvious.

Applicants also urges that there is no teaching in the references relied upon by the examiner of a step of forming a transparent siliceous coating layer on a plated layer. However, applicants appear to have overlooked the teachings of Hoffman who teaches the use of a transparent abrasion resistant film of members of a Markush group that includes SiO₂ to be coated over articles that have been previously plated with gold in order to avoid the optical discoloration of the gold and provide wear protection. See abstract. The examiner notes that gold may have various colors e.g. white, yellow, rose.

Applicants also assert that the Official Action fails to address the limitation that the unit permanent magnets of the present invention are uniaxial anisotropic magnets. However this has been pointed out in Ishikawa (Col 3 line 5) but may also be found in Sakurai, and Yellen (Col 1 lines 66-67). These teachings mean that the magnets are anisotropic with a uniaxial direction as indicated (i.e. in a direction at right angle to the longitudinal direction of a cylinder- radially or opposite surfaces of a sphere).

Applicants attack Ishikawa for not teaching point contact. However Sakurai and Yellin have taught this feature. Ishikawa has been provided only for the teaching that it was old in the jewelry art to employ magnets of strong energy product. As is well known in the magnet art rare earth magnets have high coercivity and therefore provide high

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attractive force between adjacent magnets. The magnets of claims 12 and 13 are species of rare earth magnets in a genus species relationship (See MPEP 2144.08).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEVAN A. RESAN
PRIMARY EXAMINER